

REMARKS

In the Final Office Action, the Examiner allowed claims 14 -19 and 31, and rejected claims 1-8 and 36-43. By this paper, Applicants hereby amend claim 1 to clarify certain features to expedite allowance of the present application. This amendment does not add any new matter. In view of the foregoing amendment and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections under 35 U.S.C. § 102

In the Final Office Action, claims 1-6, 8, 36, and 39 were rejected under 35 U.S.C. § 102(b) as anticipated by Clinton (U.S. Patent No. 2,666,479; hereinafter "Clinton") and claims 1-6, 8, and 36-40 were rejected under 35 U.S.C. 102(b) as being anticipated by Miller (U.S. Patent No. 2,709,446, hereinafter "Miller"). The Examiner also summarily rejected claims 41-43 in view of Clinton and Miller. *See* Final Office Action mailed on June 8, 2006, page 9. The Applicants respectfully traverse these rejections.

Legal Precedent and Guidelines

First, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); *see also In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. *See id.*

Second, interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into

how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.” See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on “usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art.” See *id.*

Third, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Fourth, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior

art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Fifth, the *drawings* of the cited reference must be evaluated for what they *reasonably disclose and suggest* to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 U.S.P.Q. 500 (CCPA 1979). Arguments based on dimensions of the drawing features are of little value where the reference does not disclose specific dimensions or any indication of whether the drawings are to scale. *See Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956, 55 U.S.P.Q.2d 1487, 1491 (Fed. Cir. 2000).

Deficiencies of Clinton

Features of Independent Claim 1 Missing from Clinton

Independent claim 1 recites “a lever mutually exclusively securable to pivot about a first portion of the torch butt or alternatively a second portion of the torch butt, wherein the second portion is disposed on the torch butt opposite the first portion, wherein the lever is disposed at least substantially outside the torch butt in an accessible position.” (Emphasis added).

In contrast, Clinton does not disclose “a lever mutually exclusively securable to pivot about a first portion of the torch butt or alternatively a second portion of the torch butt, wherein the second portion is disposed on the torch butt opposite the first portion, wherein the lever is disposed at least substantially outside the torch butt in an accessible position.” (Emphasis added). In the Final Office Action, the Examiner stated “Arm (35) is considered the reversible valve actuator claimed (see at least Figs. 3 and 4 and note reversal of this arm 35).” Final Office Action mailed on June 8, 2006, page 4. However, the arm 35 is disposed entirely inside (not outside) the handle portion 17. *See* Clinton, Figs. 2-4. As a result, the arm 35 cannot be the lever as recited by claim 1. Furthermore, the hand lever 21 cannot be the lever as recited by claim 1 for the same reasons as set forth in the previous response. Specifically, the hand lever 21 is always secured via the same two pins 33 and 34, inserted into openings 49 and 50 respectively. *See* Clinton, Figs. 2 and 5; col. 4, lines 45-75. In other words, the hand lever 21 is never mounted via pin 33 excluding pin 34 or, alternatively, via pin 34 excluding pin 33. *See id.* Even if the mounting position of the hand lever 21 is hypothetically changed, these same two pins 33 and 34 are required for the links and arms (e.g., 37 and 38) to operate in the disclosed manner. *See id.* Thus, Clinton fails to teach or suggest each and every feature of claim 1.

For at least these reasons, Applicants respectfully assert that Clinton does not anticipate independent claim 1 and its respective dependent claims 2-8. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 1-8.

Features of Independent Claim 36 Missing from Clinton

Independent claim 36 recites “a valve passage extending crosswise through the valve body relative to a longitudinal axis of the valve body.” (Emphasis added).

In contrast, Clinton discloses a central bore 24 extending lengthwise (not crosswise) along the torch 10 relative to a longitudinal axis. *See* Clinton, col. 3, lines 44-46. Similarly,

the cylindrical rod 23 extends lengthwise (not crosswise) along the torch 10 inside the central bore 24. *See* Clinton, col. 3, lines 39-46. In the Final Office Action, the Examiner failed to address this deficiency of Clinton.

For at least these reasons, Applicants respectfully submit that Clinton does not anticipate independent claim 36 and its respective dependent claims 37-40. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 36-42.

Features of Independent Claim 41 Missing from Clinton

Independent claim 41 recites “a reversible valve member disposed in the valve passage, wherein the reversible valve member is reversible relative to opposite ends of the valve passage.” (Emphasis added).

In contrast, Clinton discloses only one possible orientation of the cylindrical rod 23. Specifically, the cylindrical rod 23 has a tapered forward end 26, which engages a conical seat portion 24’ of the central bore 24 in only one orientation of the rod 23. *See* Clinton, Fig. 2; col. 3, lines 44-53. As a result, the cylindrical rod 23 cannot be reversed relative to opposite ends of the central bore 24. In the Final Office Action, the Examiner summarily rejected claims 41-43 without addressing the specific features recited in the claims. *See* Final Office Action mailed on June 8, 2006, page 9. Clearly, these claims 41-43 recite subject matter that is different from the other rejected claims. Again, the claim features recited above are missing from Clinton.

For at least these reasons, Applicants respectfully assert that Clinton does not anticipate independent claim 41 and its respective dependent claims 42-43. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 41-43.

Deficiencies of Miller

Features of Independent Claim 1 Missing from Miller

Independent claim 1 recites “a torch butt having a dedicated passage for the flow of cutting oxygen” and “a lever mutually exclusively securable to pivot about a first portion of the torch butt or alternatively a second portion of the torch butt.” (Emphasis added).

First, Miller fails to teach or suggest “a torch butt,” as recited by independent claim 1. In the Final Office Action, the Examiner argued that the preamble “torch” cannot be given any patentable weight. *See* Final Office Action mailed on June 8, 2006, pages 4-5. However, the Applicants stress that the body of claim 1 specifically recites a “torch butt.” Clearly, Miller fails to disclose any components remotely related to a torch, much less the torch butt recited in claim 1. For at least this reason, Miller cannot anticipate independent claim 1 and its dependent claims.

Second, Miller fails to teach or suggest “a dedicated passage for the flow of cutting oxygen,” as recited by independent claim 1. In the Final Office Action, the Examiner argued that the preamble “torch” cannot be given any patentable weight. *See* Final Office Action mailed on June 8, 2006, pages 4-5. However, the Applicants stress that the body of claim 1 specifically recites “cutting oxygen.” Clearly, Miller fails to disclose fluids even remotely related to a torch, much less the dedicated passage for the flow of cutting oxygen as recited in claim 1. Miller merely discloses a portable tool that operates in response to a fluid pressure. *See* Miller, col. 2, lines 1-10. Specifically, Miller discloses a pruning shear assembly 12 having blades 13 and 15. Miller clearly fails to teach or suggest cutting oxygen. In context of the claimed torch butt, the cutting oxygen feature cannot simply be ignored or discounted by the Examiner. For at least this reason, Miller cannot anticipate independent claim 1 and its dependent claims.

Third, Miller fails to teach or suggest “a lever mutually exclusively securable to pivot about a first portion of the torch butt or alternatively a second portion of the torch butt,” as recited by independent claim 1. In the Final Office Action, the Examiner argued that the “handle (64) is secured in a first orientation via pin (65) (Fig.2) and a second orientation via pin (65) that is inverted from the first orientation and considered mutually exclusively securable as recited in applicant’s claims.” Final Office Action mailed on June 8, 2006, page 5. The Examiner further stated “for instance in Figures 7 and 8 of applicant’s drawings ... single pin (80) is used to reverse the orientation of the handle and is secured in either hole (84) or hole (86).” *Id.* In view of the Examiner’s statements, the Applicants stress that Miller teaches only one pin 65 and only one corresponding hole for pivotal connection with lever 64. *See* Miller, Figs. 2 and 3; col. 3, lines 45-54. In other words, the pin 65 cannot move from one hole to another, or with reference to claim 1, from a first portion to a second portion of the portable tool. As clearly shown in Figs. 2 and 3, the lever 64 connects with the pin 65 on the same flat portion of the handle 62 opposite from the curved portion 67 despite the orientation of the handle 62. In other words, the positions of the lever 64 and pin 65 never change relative to the handle 62. For at least this reason, Miller cannot anticipate independent claim 1 and its dependent claims.

In view of the foregoing deficiencies, among others, Applicants respectfully assert that Miller does not anticipate independent claim 1 and its dependent claims 2-8. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 1-8.

Features of Independent Claim 36 Missing from Miller

Independent claim 36 recites “a valve body having a first inlet configured to receive a fuel, a second inlet configured to receive a fluid” and “a lever selectively securable to a first portion of the valve body or a second portion of the valve body opposite the first portion.” (Emphasis added).

First, Miller fails to teach or suggest “a valve body having a first inlet configured to receive a fuel, a second inlet configured to receive a fluid” as recited by independent claim 36. In the Final Office Action, the Examiner argued that the preamble “torch” cannot be given any patentable weight. *See* Final Office Action mailed on June 8, 2006, pages 4-5. However, the Applicants stress that the body of claim 36 specifically recites the “first inlet configured to receive a fuel.” Moreover, the claimed first inlet relates to a fuel, whereas the claimed second inlet relates to a fluid. In contrast, Miller simply relates to a single pressurized fluid, e.g., air. There is simply no reason for Miller to include a fuel, much less a fuel and a fluid. For at least this reason, Miller cannot anticipate independent claim 36 and its dependent claims.

Second, Miller fails to teach or suggest “a lever selectively securable to a first portion of the valve body or a second portion of the valve body opposite the first portion,” as recited by independent claim 36. In the Final Office Action, the Examiner argued that the “handle (64) is secured in a first orientation via pin (65) (Fig.2) and a second orientation via pin (65) that is inverted from the first orientation and considered mutually exclusively securable as recited in applicant’s claims.” Final Office Action mailed on June 8, 2006, page 5. The Examiner further stated “for instance in Figures 7 and 8 of applicant’s drawings ... single pin (80) is used to reverse the orientation of the handle and is secured in either hole (84) or hole (86).” *Id.* In view of the Examiner’s statements, the Applicants stress that Miller teaches only one pin 65 and only one corresponding hole for pivotal connection with lever 64. *See* Miller, Figs. 2 and 3; col. 3, lines 45-54. In other words, the pin 65 cannot move from one hole to another, or with reference to claim 36, from a first portion to a second portion of the portable tool. As clearly shown in Figs. 2 and 3, the lever 64 connects with the pin 65 on the same flat portion of the handle 62 opposite from the curved portion 67 despite the orientation of the handle 62. In other words, the positions of the lever 64 and pin 65 never change relative to the handle 62.

For at least this reason, Miller cannot anticipate independent claim 36 and its dependent claims.

In view of the foregoing deficiencies, among others, Applicants respectfully assert that Miller does not anticipate independent claim 36 and its dependent claims 37-40. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 36-40.

Features of Independent Claim 41 Missing from Miller

Independent claim 41 recites “a torch, comprising: a combustion tip; a body coupled to the combustion tip; a fuel inlet coupled to the body upstream from the combustion tip; an oxygen inlet coupled to the body upstream from the combustion tip.” (Emphasis added).

First, Miller fails to teach or suggest a “torch,” as recited by independent claim 41. In the Final Office Action, the Examiner argued that the preamble “torch” cannot be given any patentable weight. *See* Final Office Action mailed on June 8, 2006, pages 4-5. However, the Applicants stress that the body of claim 41 specifically recites a “torch.” For at least this reason, Miller cannot anticipate independent claim 41 and its dependent claims.

Second, Miller fails to teach or suggest a “combustion tip,” as recited by independent claim 41. Again, Miller merely discloses a portable tool without any mention of combustion, much less a combustion tip. *See* Miller, col. 1, lines 15-38. For at least this reason, Miller cannot anticipate independent claim 41 and its dependent claims.

Third, Miller fails to teach or suggest a “fuel inlet” and an “oxygen inlet,” as recited by independent claim 41. Clearly, Miller fails to disclose fluids even remotely

related to a torch, much less the fuel and oxygen inlets as recited in claim 41. Miller merely discloses a portable tool that operates in response to a single fluid pressure, e.g., air. See Miller, col. 2, lines 1-10. There is simply no reason for Miller to include a fuel inlet, much less a fuel inlet and an oxygen inlet. For at least this reason, Miller cannot anticipate independent claim 41 and its dependent claims.

For at least these reasons, Applicants respectfully assert that Miller does not anticipate independent claim 41 and its respective dependent claims 42-43. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of claims 41-43.

Rejections under 35 U.S.C. § 103

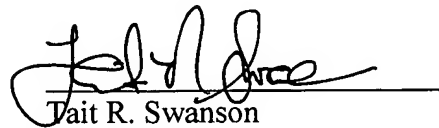
In the Final Office Action, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Clinton and Dimock et al. (U.S. Patent No. 5,571,427; hereinafter "Dimock"), and as being obvious in view of Miller and Dimock. Applicants, however, respectfully assert that dependent claim 7 is patentable at least by virtue of its dependence on allowable base claim 1. Keeping in mind the foregoing arguments regarding Clinton and Miller, Applicants respectfully assert that Dimock does not obviate the deficiencies of the primary references. Accordingly, Applicants respectfully assert that dependent claim 7 is patentable not only by virtue of its dependence on independent claim 1, but also by virtue of the additional features recited therein. For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent claim 7.

Conclusion

If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: July 21, 2006

A handwritten signature in black ink, appearing to read 'Tait R. Swanson', is written over a horizontal line.

Tait R. Swanson
Reg. No. 48,226
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545